

REMARKS

Entry of the foregoing amendments after final rejection as narrowing the issues and presenting the claims in condition for allowance or in better condition for appeal is respectfully solicited. The foregoing amendments after final rejection have not been earlier presented because of the new grounds for rejection.

On August 25, 2006, the applicants filed a "Petition To Withdraw Holding Of Finality Of Final Rejection Dated June 26, 2006." Although the present "Amendment 'C' After Final Rejection" is being filed in response to the final action of June 26, 2006, the applicants respectfully request that any further action be held until resolution of the above-mentioned petition so as to clarify the prosecution of the application.

Claims 12-20 are pending and at issue in the application with claims 12 and 13 being independent claims. Claims 12 and 13 have been amended. As a result, two independent claims remain in the application as previously paid for, and nine total claims remain in the application as previously paid for. The applicants believe no fee is due. However, the commissioner is hereby authorized to charge any deficiency in the amount enclosed or any additional fees which may be required under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 13-2855. Reconsideration and withdrawal of the rejections in view of the remarks below is respectfully requested.

Turning to the prior art rejections, the applicants respectfully traverse the rejections of claims 12-20 as unpatentable over Porter (U.S. Patent No. 5,774,053) in view of Frisch (U.S. Patent No. 5,212,644) under 35 U.S.C. §103(a). In particular, neither Porter nor Frisch teach or suggest all of the limitations of independent claims 12 and 13, one of ordinary skill in the art would not be motivated to combine Porter and Frisch, and Frisch is non-analogous art.

Independent claims 12 and 13 have been amended to clarify that information of registered users is acquired via a user interface. Each of claims 12-20 recite an electronic parcel compartment system or method of operating an electronic parcel compartment system where, after assignment of a registered user to a user group, a function can be activated that causes an essentially simultaneous opening of several parcel compartments.

The applicants submit that the action does not establish a *prima facie* case of obviousness because neither Porter nor Frisch teach or suggest all of the limitations of independent claims 12 and 13. In particular, Porter does not teach an essentially simultaneous opening of several parcel compartments, as acknowledged in the action. (See June 26, 2006 final official action, page 3). Likewise, Frisch does not teach or suggest an essentially simultaneous opening of several parcel compartments. Although Frisch discloses a luggage locker system that permits a centralized opening of multiple lockers, there is no disclosure that the lockers are opened simultaneously. Instead, Frisch only discloses that more than one locker may be opened from a remote location. For example, while Frisch discloses that the same remote control unit may be used with different lockers (see cited column 3, lines 38-40) and that a central location allows the lockers to be controlled singling or in blocks (see cited column 3, lines 55-57), this only discloses that multiple lockers may be controlled with the same unit. This does not disclose that such control includes the simultaneous opening of multiple lockers. Likewise, while Frisch discloses that a central control can open all lockers to allow police searches (see cited column 1, lines 56-60), this does not teach or suggest that all lockers will open simultaneously. Instead, Frisch only discloses the manner of control, but does not disclose how the lockers respond (e.g., one-by-one opening versus simultaneous opening). Likewise, while Frisch discloses a second central unit at a police station to allow authorities to open all or selected lockers to conduct searches (see cited column 4, lines 35-40), again no teaching or suggestion is provided that all or selected lockers will open simultaneously. As a result, neither Porter nor Frisch discloses or suggests all of the limitations of independent claims 12 and 13.

Further, the combination of Porter and Frisch does not teach or suggest that simultaneous opening is effected by the assignment of a user to a user group after the user information of the user was acquired. Instead, the combination of Porter and Frisch would lead to a compartment system according to Porter that uses a central control unit to remotely open several compartments. However, simultaneous opening would not be effected by the assignment of a user to a user group after the user information of the user was acquired via an interface of the compartment system, as recited in independent claims 12 and 13. It is clear that to “establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); See also MPEP 2143.03. As a result, one of ordinary skill in the art would not

be lead to a combination of Porter and Frisch that discloses the compartments system and method of independent claims 12 and 13.

The applicants submit that the action does not establish a *prima facie* case of obviousness because the asserted motivation is an insufficient motivation or suggestion to modify or combine Porter and Frisch. In particular, Frisch does not teach or suggest that simultaneous opening is advantageous, because Frisch only discloses opening more than one locker by means of a remote central control unit, but does not disclose how the lockers respond to the control, as established above. To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See MPEP 2143. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See MPEP 2143.01. As a result, allowing authorities to conduct search procedures as disclosed in Frisch would not motivate one of ordinary skill in the art to modify or combine Porter and Frisch to provide simultaneous opening of several parcel compartments, as recited by independent claims 12 and 13. See MPEP

The applicants submit that the action does not establish a *prima facie* case of obviousness because Frisch involves non-analogous art, and therefore the combination of Porter and Frisch fails to motivate one of ordinary skill in the art to modify or combine the teachings of Porter and Frisch. In particular, Frisch discloses a luggage locker system that incorporates variable rental rates. (See abstract). However, there are basic differences between a luggage locker system as disclosed in Frisch and an electronic parcel compartment system, such that one of ordinary skill in the art would not be lead to consider Frisch when constructing an electronic parcel compartment system as recited by independent claims 12 and 13. For example, in a luggage locker system, a user deposits a piece of luggage in a compartment box and after a while picks up the luggage. After depositing a piece of luggage, a random 5-digit passcode is generated. The code must be entered by the user at the end of the rental period to open the locker upon payment of any required fee. (See column 8, lines 27-35). Since luggage locker systems can be used by everyone, no user information for every user of the system is required.

On the other hand, a parcel compartment system as recited by independent claims 12 and 13 is accessible for registered users only. Deliverers, recipients and maintenance technicians are registered with their personal user information. They may enter their personal user card or a PIN at a user interface, and in either case the individual user information can be derived from these access means. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if no, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992); See also MPEP 2141.01(a). As a result, the luggage locker system of Frisch relates to an area of technology and addresses a problem different from that of the application and Porter, and one of ordinary skill in the art would not be motivated to modify or combine Porter with the system of Frisch to simultaneously open several parcel compartments, as recited by independent claims 12 and 13.

Accordingly, the applicants respectfully submit that independent claims 12 and 13 are novel and non-obvious in view of the cited references and should be allowed. Further, dependent claims 14-20, which are dependent upon the aforementioned independent claims are also submitted to be in allowable form. In light of the foregoing, the prompt issuance of a notice of allowance is respectfully solicited. Should the examiner have any questions, the examiner is respectfully invited to telephone the undersigned.

Respectfully submitted,

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